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William D. Lanyi, Esq.
Mercury Marine
W6250 Pioneer Road
P.O. Box 1939
Fond du Lac, WI 54936-1939

EXAMINER

WRIGHT, ANDREW D

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| ART UNIT | PAPER NUMBER |
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3617

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,094

Applicant(s)

BRUESTLE, CLAUS

Examiner

Andrew Wright

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-31 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/31/03, 3/4/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 4, 12, 13, 19-21, 25, and 30 are objected to. Claim 4 recites the limitation "the fluid connection" in line 2. There is insufficient antecedent basis for this limitation in the claim. A positive recitation should be used and will be assumed for examination purposes. The same objectionable language is used in claim 25. Appropriate correction is required.
2. Claim 12 recites the limitation "said engine" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. A positive recitation should be used and will be assumed for examination purposes. The same objectionable language is used in claims 13, 19-21, and 30. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (JP 2-212295). Kato discloses a cowl with a cavity for receiving an engine. An opening (not numbered) bounded by gasket (44) is formed in the top portion of the cowl (figure 3). The cavity forms an air passage that takes air from the opening to the intake

for the engine. Door (50) is an air control mechanism that can be in a first position (closed) or a second position (open). The door controls air flow through the passage.

5. Regarding claim 6, the plate (50) is a rotatable air deflection device.

6. Claim 7, the door (50) is proximate the opening.

7. Claim 11, the internal surfaces of the cowl form the air passage.

8. Claims 1, 8-10, 14, and 22 are rejected 35 U.S.C. 102(b) as being anticipated by Kawamukai et al. (US 5,340,343). Kawamukai shows an outboard motor with a cowl. The cowl has an opening (42). The cowl has an air passage (47). The opening is the inlet of the air passage. Kawamukai discloses a carburetor (28) at the end of air passage (47). The carburetor is an air flow control mechanism. The skilled artisan will recognize that the carburetor controls the flow of air through the air passage (47) by moving parts (generally a valve) between discrete positions that will include at least a first position and a second position.

9. Regarding claim 8, the air passage extends within the cavity (figure 2) between the inlet (42) and the outlet at carburetor (28).

10. Claim 9, the air passage is formed integrally with the cowl (column 4 lines 1-5), and therefore is defined by the structure of the cowl.

11. Claim 10, the inlet (42) and outlet are at opposite ends of the passage (47).

12. Claim 14, the carburetor (28) is proximate the outlet.

13. The elements of claim 22 are present in Kawamukai as already described.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-4, 15, 16-18, 23-25, 27-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 2-212295) in view of Saito (US 6,726,512). Kato discloses all of the elements of claim 1. Kato does not disclose that the engine has a throttle body. Saito discloses an outboard engine with a cowl that defines a cavity (62). An engine is disposed within the cavity. The engine has a throttle body (118). The engine has an intake conduit (120) in fluid communication with the throttle body. The cavity (62) constitutes an air passage between the intake openings in the cowl (60) and the intake passage (120) (lines 33-36 of column 4, and lines 63-6 of column 5). Since Kato does not disclose the specifics of the engine in his invention, one making and using the invention of Kato would necessarily need to provide an engine. It would be obvious to look to the prior art for such an engine. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Saito engine in the outboard motor arrangement shown by Kato. The motivation would be to use a known engine with the cowl shown by Kato.

16. Regarding claim 15, the engine is part of an outboard motor.

17. Regarding claims 16-18, Kato in view of Saito contains all of the structural elements of the claims. Kato in view of Saito does not specifically disclose the recited

method steps. The method steps, however, are inherent in the making and use of the modified invention of Kato. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon the making and use of the modified invention of Kato. The motivation would be to make and use the modified invention.

18. Regarding claim 23, Kato discloses the cowl with cavity, opening, and air flow control mechanism (50). Kato also shows a passage within the cavity, the passage at least partly defined by wall (48) and wall (26) as shown in figure 3. The passage has an outlet (not numbered) where intake air enters the cavity. Kato as modified in view of Saito as described above has an engine within the cavity and the engine has a throttle body (claim 23), the engine has an intake conduit in communication with the throttle body (claim 24), the air passage is a fluid connection between the opening and the throttle body (claim 25), the air control mechanism (50) is a rotatable air deflection device (claim 27), the mechanism (50) is disposed proximate the opening (claim 28), and the inlet and outlet of the passage are defined by the cowl (claim 29). The engine is an outboard motor (claim 30).

19. Claims 1, 5, 12, 13, 16, 19-21, 22, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamukai et al. (US 5,340,343) in view of House et al. (US 6,056,611) and Saito (US 6,726,512). Kawamukai discloses the elements of claim 1. Kawamukai does not specifically show that the air flow control mechanism comprises a rotatable throttle plate. House discloses an outboard motor and teaches the

equivalence between a carburetor and a throttle body (column 4, lines 11-12). Saito discloses an outboard motor with a throttle body that comprises a rotatable throttle plate (122). Kawamukai does not place any criticality on the design of the carburetor.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kawamukai by using the throttle body with throttle plate shown by Saito. The motivation would be to use a throttle device that is known in the art. The modified invention of Kawamukai has a throttle body with rotatable throttle plate in the place of carburetor (28). Thus the throttle body is the air flow control mechanism at the end of air passage (47). And the air flow control mechanism comprises a rotatable throttle plate.

20. Regarding claims 12 and 13, Saito teaches that the throttle (118, 120) is connected in signal communication to an ECU (150) and that the ECU controls the position of the throttle plate (120). The ECU has an engine speed calculating unit that adjusts the throttle (120) based upon desired engine speed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Kawamukai by adding the ECU shown by Saito. The motivation would be to provide the electronic control arrangement disclosed by Saito.

21. Regarding claims 16 and 19-21, Kawamukai modified in view of House and Saito contains all of the structural elements of the claims. Kawamukai modified in view of House and Saito does not specifically disclose the recited method steps. The method steps, however, are inherent in the making and use of the modified invention of Kawamukai. Therefore it would have been obvious to one having ordinary skill in the art

at the time the invention was made to devise the claimed method steps based upon the making and use of the modified invention of Kawamukai. The motivation would be to make and use the modified invention.

22. Kawamukai discloses the elements of claim 23 as already described.

Kawamukai modified in view of House and Saito contains the elements of claim 30.

Allowable Subject Matter

23. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

24. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest the claimed combination specifically comprising an engine with a throttle body and an air flow control mechanism comprising a rotatable throttle plate.

Conclusion

25. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for

official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

Av 7/9/04